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PATENT
PU020345

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

Applicant: Valerie Sacrez Liebhold
Serial No.: 10/521,386
Filed: 18 January 2005
For: METHOD AND APPARATUS FOR DISPLAYING NUMBER
OF VIDEO TITLES AVAILABLE AT POWER ON
Examiner: Christopher G. Findley
Art Unit: 2482
Conf. No.: 2347

APPEAL BRIEF

Mail Stop: Appeal Brief - Patents
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May It Please The Honorable Board:

This is Appellant's Brief on Appeal from the Final Rejection of Claims 1 - 18. This Appeal Brief is being filed concurrently with a Notice of Appeal. Please charge the fee for filing this Brief, the Notice of Appeal and a two-month extension of time to Deposit Account No. 07-0832. The Appellant waives an oral hearing for this appeal.

Please charge any additional fee or credit any overpayment to the above indicated Deposit Account. Enclosed is a single copy of this Brief.

I. Real Party In Interest

The real party in interest of Application Serial number 10/521,386 is the assignee of record:

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II. RELATED APPEALS AND INTERFERENCES

There are currently, and have been, no related Appeals or Interferences regarding Application Serial No. 10/521,386, known to the undersigned attorney.

III. Status of the Claims

Claims 1 to 18 have been rejected. The rejection of all Claims is appealed.

IV. Status of Amendments

All amendments were entered and are reflected in the Claims included in Appendix I.

V. Summary of Claimed Subject Matter

Independent Claim 1 sets forth a method for controlling a digital video recording apparatus (page 1, lines 9 -10), comprising the steps of: receiving a plurality of signals corresponding to a plurality of video programs from a signal source (page 2, line 34 – page 3, line1; page 4, lines 15 -18; page 5, lines 10 – 12); selecting ones of the plurality of video programs for recording in response to user commands (page 3, lines 1- 2; page 6, lines 22 – 25, page 7, lines 3 – 12); storing the selected video programs in a storage device (page 3, lines 2 – 3, page 6, lines 4 – 17);

maintaining data related to the video programs stored in the storage device (page 3, lines 3 -4, page 5, lines 1 - 2, page 7, lines 11 - 13, page 7, lines 20 - 26); and providing, in response to the digital video recording apparatus being placed in a power ON state, an initial on screen display message indicating a numerical value representing a number of available video programs stored in the storage device (page 2, lines 30 - 32, page 3, lines 4 - 7, page 7, lines 21 - 31, page 9, lines 8 - 11).

Dependent Claim 2 sets forth, in addition to the recitations of Claim 1, wherein the numerical value comprises a number of video programs stored in the storage device since a last time the apparatus was in the power ON state (page 3, lines 8 - 10, page 8, line 33 - page 9, line 1).

Dependent Claim 3 sets forth, in addition to the recitations of Claim 2, wherein the initial on screen display message further displays selected attributes of the available video programs stored in the storage device (page 3, lines 7 - 8).

Dependent Claim 4 sets forth, in addition to the recitations of Claim 3, wherein the selected attributes include titles of the available video programs (page 3, lines 8 - 9).

Dependent Claim 5 sets forth, in addition to the recitations of Claim 3, wherein the selected attributes include times the available video programs were stored in the storage device (page 3, lines 7 - 8).

Dependent Claim 6 sets forth, in addition to the recitations of Claim 1, wherein the number of available video programs comprises a number of video programs stored in the storage device since a last time a user accessed a full program listing display of all programs stored on the storage device (page 3, lines 11 - 13, page 7, lines 23 - 25, page 9, lines 1 - 4).

Dependent Claim 7 sets forth, in addition to the recitations of Claim 6, wherein the initial on screen display message further displays selected attributes of the available video programs stored in the storage device (page 3, lines 7 - 8).

Dependent Claim 8 sets forth, in addition to the recitations of Claim 7, wherein the selected attributes include titles of the available video programs (page 3, lines 7 – 8).

Dependent Claim 9 sets forth, in addition to the recitations of Claim 7, wherein the selected attributes include times the available video programs were stored in the storage device (page 3, lines 7 – 8).

Independent Claim 10 sets forth, digital video recording apparatus (page 1, lines 9 -10), comprising a signal input for receiving a plurality of signals corresponding to a plurality of video programs from a signal source (page 3, lines 15 -16, page 4, lines 15 – 18, page 5, lines 10 – 12); tuning means for selecting ones of the plurality of video programs in response to user commands (page 3, lines 17 - 18, page 5, lines 10 – 12); recording means for storing the selected video programs in a storage device response to further user commands (page 3, lines 17 – 18, page 6, lines 4 – 16); generating means for generating on screen display messages (page 3, line 19, page 4, lines 15 – 17, page 5, lines 14 - 21, page 7,, lines 27 – 28); control means, coupled to and controlling operation of the tuning means, the recording means and the generating means, the control means causing the generating means to generate, in response to the apparatus being placed in a power ON state, an initial on screen display message indicating a numerical value representing a number of available video programs stored in the storage device (page 3, lines 19 – 24, page 7, lines 21 - 31, page 9, lines 8 - 11).

Dependent Claim 11 sets forth, in addition to the recitations of Claim 10, wherein the numerical value comprises a number of video programs stored in the storage device since a last time the apparatus was in the power ON state (page 3, lines 25 – 27, page 8, line 33 – page 9, line 1).

Dependent Claim 12 sets forth, in addition to the recitations of Claim 11, wherein the initial on screen display message further displays

selected attributes of the available video programs stored in the storage device (page 3, lines 24 - 25).

Dependent Claim 13 sets forth, in addition to the recitations of Claim 12, wherein the selected attributes include titles of the available video programs (page 3, lines 24 - 25).

Dependent Claim 14 sets forth, in addition to the recitations of Claim 12, wherein the selected attributes include times the available video programs were stored in the storage device (page 3, lines 24 - 25).

Dependent Claim 15 sets forth, in addition to the recitations of Claim 10, wherein the number of available programs comprises a number of video programs stored in the storage device since a last time the user accessed a full program listing display that lists all video programs stored on the storage device.(page 3, lines 28 - 30, page 7, lines 23 - 25, page 9, lines 1 - 4).

Dependent claim 16 sets forth, in addition to the recitations of Claim 15, wherein the initial on screen display message further displays selected attributes of the available video programs stored in the storage device (page 3, lines 24 - 25).

Dependent Claim 17 sets forth, in addition to the recitations of Claim 16, wherein the selected attributes include titles of the available video programs (page 3, lines 24 - 25).

Dependent Claim 18 sets forth, in addition to the recitations of Claim 16, wherein the selected attributes include times the available video programs were stored in the storage device (page 3, lines 24 - 25).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner has rejected Claims 1 - 18 under 35 USC § 103 (a) as unpatentable over Goto US 7,158,713 (hereinafter "Goto") in view of Ettlinger US 4,746,994 (hereinafter "Ettlinger").

VII. ARGUMENT

This invention relates to a method and apparatus for controlling a digital video recording apparatus, in which, in response to the digital video recording apparatus being placed in a power on state, an on-screen display message indicates a numerical value representing a number of available video programs stored in a storage device. Nowhere does the art cited by the Examiner affect the patentability of the claimed invention.

Cited US 7,158,713 to Goto et al shows an apparatus which records information on two different media: a non-removable hard disk, and removable tape. The hard disc records a sequence of broadcast programs. Desired programs are dubbed onto the tape. Thumbnails of programs recorded on tape are recorded onto the hard disk. A user may cause thumbnails of the recorded programs to be displayed. If a user wants to determine the number of available programs associated with the apparatus, the user must count the number of thumbnails. Nowhere does Goto et al show or suggest:

“providing, in response to the digital video recording apparatus being placed in a power ON state, an initial on screen display message indicating a numerical value representing a number of available video programs stored in the storage device”,

as specifically recited in Claim 1. The Examiner has admitted as much, and looks to cited US 4,746,994 to Ettlinger for this feature. The Appellant cannot agree with the Examiner that both references relate to video editing systems. Nevertheless, nowhere does Ettlinger show or suggest an initial on screen display message indicating a numerical value representing a number of available video programs. Rather, the first display screen of Ettlinger, seen when the invention is started up, is a display which shows which data files are present on the disc in the lower drive. If a user desires a numerical value representing a number of

available video programs, such user must count the number of data files. See column 20, lines 11-15. It is therefore clear that even if the structure of Ettlinger were to be combined with the structure of Goto et al, the patentability of Claim 1 would not be affected.

Similarly, nowhere does either Goto et al or Ettlinger show or suggest:

“the control means causing the generating means to generate, in response to the apparatus being placed in a power ON state, an initial on screen display message indicating a numerical value representing a number of available video programs stored in the storage device”,

as specifically set forth in Claim 10. It is therefore clear that the cited references, taken either singly or in combination, do not affect the patentability of Claim 10.

Claims 2-9 are dependent from Claim 1 and add further advantageous features. The Applicant submits that these subclaims are patentable as their parent Claim 1.

Similarly, Claims 11-18 are dependent from Claim 10, and add further advantageous features. The Applicant submits that these subclaims are patentable as their parent Claim 10.

The Examiner has cited a 1958 decision of the CCPA. The Applicant assumes that the Examiner meant to cite In Re Venner and Bowser, 262 F² 91, 120 USPQ 193, 46 CCPA 754 (1958). The Appellant submits that this decision does not affect the instant application.

In Re Venner and Bowser relates to a molding apparatus for pistons. The moment in time at which a piston is withdrawn from its mold is controlled by a timing device. The prior art shows such moment in time to be controlled by the operator of the molding apparatus. The CCPA stated that it is not “invention” to broadly provide a mechanical or

automatic means to replace manual activity which has accomplished the same result.

The instant invention provides, in response to the digital video recording apparatus being placed in a power on state, an initial on screen display message indicating a numerical value representing a number of available video programs stored in the storage device. The Examiner agrees that the prior art does not show such an initial on screen display message. Rather, in order for a user to determine the number of available programs stored in the storage device, the user must count the number of thumbnails. This is an additional step which does not occur in response to the digital video recording apparatus being placed in a power on state.

It is therefore clear that In Re Venner and Bowser has no application to the instant invention, since the prior art cited by the Examiner neither shows nor suggests any manual step, which occurs when the recording apparatus is placed in a power on state, which may be replaced by an automated step of providing an initial on-screen display message indicating a numerical value representing a number of available video programs stored in the storage device. The present invention goes beyond providing automatic means to replace manual activity. The present invention has an additional step, which is not present in either Goto or Ettlinger.

Furthermore, the Examiner argues in the advisory action that In Re Venner and Bowser is universally applicable to the automation by a machine (apparatus) of a manual or mental activity. The Appellant does not argue that the principles of law set forth in In Re Venner and Bowser are not universally applicable. Rather, the Appellant argues that the instant invention is more than automation of a manual or mental activity. Nowhere does either Goto or Ettlinger show or suggest an initial on-screen display message indicating a numerical value representing a number of available video programs stored in a storage device, in response to a digital video recording apparatus being placed in a power on state, as set

forth in *all* Claims of the instant application. Rather, the instant invention provides an additional step, not shown or suggested by either Goto or Ettlinger. It is therefore clear that In Re Venner and Bowser is not applicable to the instant invention.

No fee is believed to have been incurred by virtue of this response. However if a fee is incurred on the basis of this response, please charge such fee against Deposit Account No. 07-0832.

VIII. CONCLUSION

The Appellant therefore submits that all of the Claims in the Application fully comply with all requirements of the Statutes and Rules. The Appellant submits that the Examiner's rejection should be completely reversed.

Respectfully submitted,

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Attachment: Appendix I Appealed Claims
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February 22, 2011

APPENDIX I APPEALED CLAIMS

1. A method for controlling a digital video recording apparatus, comprising the steps of:

receiving a plurality of signals corresponding to a plurality of video programs from a signal source;

selecting ones of the plurality of video programs for recording in response to user commands;

storing the selected video programs in a storage device;

maintaining data related to the video programs stored in the storage device; and

providing, in response to the digital video recording apparatus being placed in a power ON state, an initial on screen display message indicating a numerical value representing a number of available video programs stored in the storage device.

2. The method according to claim 1, wherein the numerical value comprises a number of video programs stored in the storage device since a last time the apparatus was in the power ON state.

3. The method according to claim 2, wherein the initial on screen display message further displays selected attributes of the available video programs stored in the storage device.

4. The method according to claim 3, wherein the selected attributes include titles of the available video programs.

5. The method according to claim 3, wherein the selected attributes include times the available video programs were stored in the storage device.

6. The method according to claim 1, wherein the number of available video programs comprises a number of video programs stored in the storage device since a last time a user accessed a full program listing display of all programs stored on the storage device.

7. The method according to claim 6, wherein the initial on screen display message further displays selected attributes of the available video programs stored in the storage device.

8. The method according to claim 7, wherein the selected attributes include titles of the available video programs.

9. The method according to claim 7, wherein the selected attributes include times the available video programs were stored in the storage device.

10. A digital video recording apparatus, comprising:
a signal input for receiving a plurality of signals corresponding to a plurality of video programs from a signal source;

tuning means for selecting ones of the plurality of video programs in response to user commands;

recording means for storing the selected video programs in a storage device response to further user commands;

generating means for generating on screen display messages;

control means, coupled to and controlling operation of the tuning means, the recording means and the generating means, the control means causing the generating means to generate, in response to the apparatus being placed in a power ON state, an initial on screen display message indicating a numerical value representing a number of available video programs stored in the storage device.

11. The apparatus according to claim 10, wherein the numerical value comprises a number of video programs stored in the storage device since a last time the apparatus was in the power ON state.

12. The apparatus according to claim 11, wherein the initial on screen display message further displays selected attributes of the available video programs stored in the storage device.

13. The apparatus according to claim 12, wherein the selected attributes include titles of the available video programs.

14. The apparatus according to claim 12, wherein the selected attributes include times the available video programs were stored in the storage device.

15. The apparatus according to claim 10, wherein the number of available programs comprises a number of video programs stored in the storage device since a last time the user accessed a full program listing display that lists all video programs stored on the storage device.

16. The apparatus according to claim 15, wherein the initial on screen display message further displays selected attributes of the available video programs stored in the storage device.

17. The apparatus according to claim 16, wherein the selected attributes include titles of the available video programs.

18. The apparatus according to claim 16, wherein the selected attributes include times the available video programs were stored in the storage device.